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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,774	03/30/2001	Jonathan Sobel	57983.000046	6976

7590 03/08/2006

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EXAMINER

NAHAR, QAMRUN

ART UNIT

PAPER NUMBER

2191

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/822,774	Applicant(s) SOBEL ET AL.	
	Examiner Qamrun Nahar	Art Unit 2191	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-8 and 10-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8 and 10-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This office action is in response to the amendment filed on 12/12/2005.
2. Claims 1-3, 5-8, 10-13 are pending.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11 and 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 11 recites “at least one processor readable carrier, and instruction carried on the at least one carrier” which is non-statutory as not being tangibly embodied in a manner so as to be executable.

Claim 13 recites “A signal embodied in a carrier wave” which is non-statutory as not being tangibly embodied in a manner so as to be executable.

The Office's current position is that claims involving signals encoded with functional descriptive material do not fall within any of the categories of patentable subject matter set forth in 35 U.S.C. § 101, and such claims are therefore ineligible for patent protection. *See* 1300 OG 142 (November 22, 2005), in particular, see Annex IV(c).

4. Claims 1-3, 5-8 and 10-12 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Piazza in view of McGuire (See the previous office action for the rejection to these claims).

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5. Claim 13 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Piazza in view of McGuire, further in view of Bak (See the previous office action for the rejection to these claims).

***Response to Arguments***

6. Applicant's arguments filed on 12/12/2005 have been fully considered but they are not persuasive.

In the remarks, applicant argues that

1) claims 11 and 13 satisfy the requirements of 35 USC 101

Examiner's response:

1) The Office's current position is that claims involving signals encoded with functional descriptive material do not fall within any of the categories of patentable subject matter set forth in 35 U.S.C. § 101, and such claims are therefore ineligible for patent protection. *See* 1300 OG 142 (November 22, 2005), in particular, see Annex IV(c).

In the remarks, applicant argues that

2) the motivation of "providing more choices" is not one that would lead to the claimed invention

Examiner's response:

2) McGuire is cited to disclose that C++ was well known at the time the invention was made. Therefore, it would have been obvious to apply Piazza's method to a different

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well known language such as C++. As it stated in the previous office action that the modification would have been obvious because one of ordinary skill in the art would have been motivated to provide more choices to use when choosing an object oriented language like Scheme, Lisp and C++ as a development tools to develop the computer system. Note that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one would want to provide more choices to use when choosing an object oriented language like Scheme, Lisp and C++ as a development tools to develop the computer system.

Applicant has failed to look at the whole motivation. As it stated in the previous office action that the modification would have been obvious because one of ordinary skill in the art would have been motivated to provide more choices to use when choosing an object oriented language like Scheme, Lisp and C++ as a development tools to develop the computer system. The motivation did not *merely* say "providing more choices".

In the remarks, applicant argues that

3) the combination of Piazza and McGuire fails to disclose or suggest a compiler for C/C++ programs

Examiner's response:

3) In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., compiler for C/C++ programs) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In the remarks, applicant argues that

4) McGuire does not disclose or suggest C/C++. Therefore, the combination of Piazza and McGuire fails to disclose or suggest "a first C/C++ program".

Examiner's response:

4) For example, see col. 8, lines 32-37, where McGuire discloses "the system and method for variables representing Quantities is implemented in an object oriented language from Curl Corporation. The language allows the creation of objects and has similar capabilities to those found in languages such as Scheme, Lisp and C++." (emphasis added). Therefore, McGuire suggests C/C++.

In the remarks, applicant argues that

5) Bak does not cure the deficiencies of the combination of Piazza and McGuire.

Examiner's response:

5) In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections

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are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

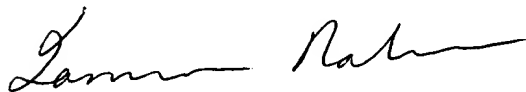
8. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (571) 272-3730. The examiner can normally be reached on Mondays through Fridays from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y Zhen, can be reached on (571) 272-3708. The fax phone number for the organization where this application or processing is assigned is (571) 273-8300.

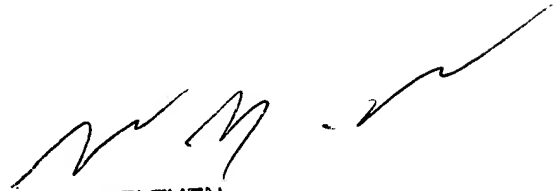
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Lam" followed by a stylized flourish.

QN  
March 2, 2006

A handwritten signature in black ink, appearing to read "Wei Zhen" followed by a long horizontal flourish.

WEI ZHEN  
SUPERVISORY PATENT EXAMINER